

DETAILED ACTION

Status of the Claims

Claim 7 is cancelled. Claims 2-6 and 10-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/27/2009.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 3747

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sodemann et al. (US Patent No. 7,148,580).

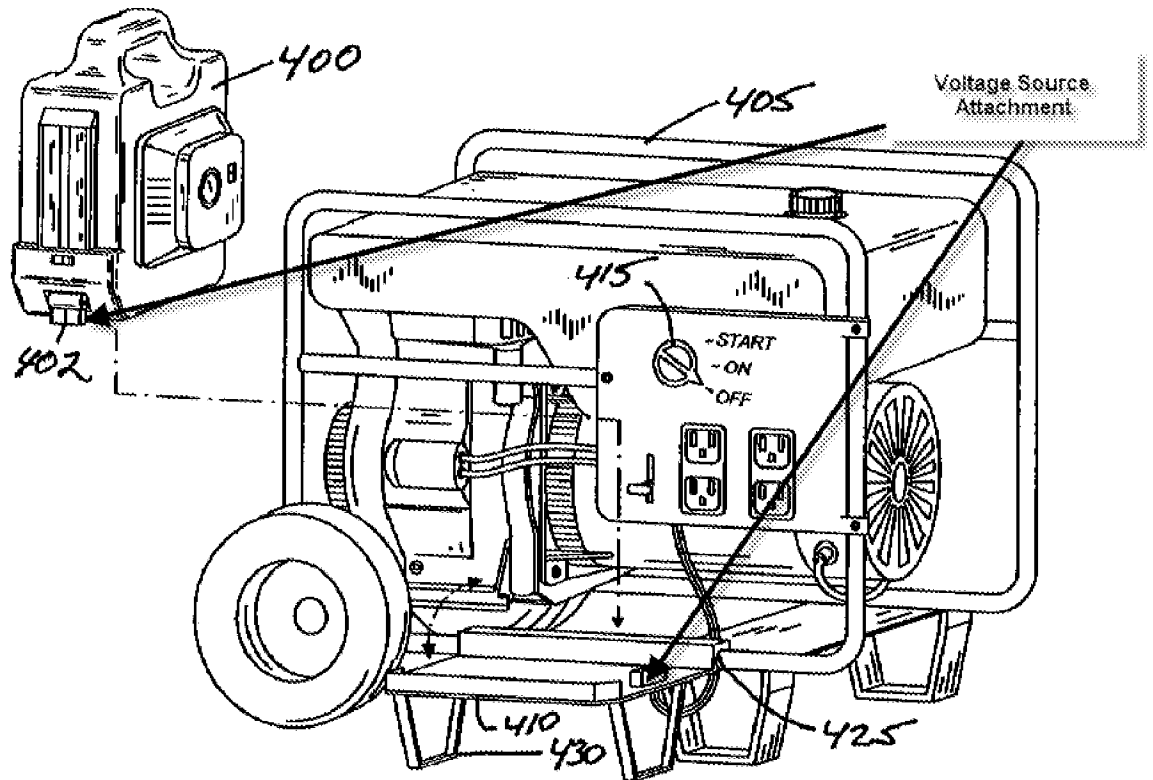
With regards to claim 1, the patent to Sodemann et al. discloses all the limitations of the claimed subject matter including a work machine (90) comprising at least one combustion engine (100, See Col. 6, Lines 5-10) which in operation requires a supply voltage, and comprising a voltage generator (i.e. generator 90) which supplies a generator voltage that depends on the rotary speed of the combustion engine (100), which generator voltage is used to generate the supply voltage, characterized in that: the handheld work machine (90) is electrically connected to an additional voltage source (10) that prior to starting the combustion engine (100) provides the required supply voltage that at this point in time is not yet present, wherein in the handheld work machine the supply voltage required during operation of the combustion engine (100) is split into an ignition voltage and a control voltage, and the additional voltage source (10) only supplies the required control voltage prior to the start of the engine (100), except positively disclosing a 'handheld' work machine in the same embodiment.

Since Sodemann et al. explicitly states on Col. 5, Lines 50-55 that "Although the principles of the invention are illustrated as being applied to a portable generator, other

Art Unit: 3747

types of outdoor power equipment (lawn and garden equipment, snow moving equipment, pressure washers, etc.)" it would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the portable generator of one embodiment with a handheld work machine in view of the teaching to Col. 5, Lines 50-60 regarding using the auxiliary voltage source (10) with garden tools, in order to provide sufficient voltage for starting purposes (Col. 1, Lines 10-15 from Sodemann et al.)

As to the newly added limitation of "additional integrated voltage source that can be plugged to or in or into the housing of the handheld work machine", the reference to Sodemann ostensibly discloses an integrated voltage source in Figure 12 as provided below.

**FIG. 12**

With regards to claim 7, the patent to Sodemann et al. discloses that the additional voltage source (10) can be plugged to or in or into (via connector 92) the housing of the handheld work machine (i.e. portable generator 90).

With regards to claim 8, the patent to Sodemann et al. discloses that the additional voltage source (10) is arranged externally in relation to the housing of the handheld work machine (90) and is electrically connected to the work machine (90) by way of an electrical conductor and a plug-type connection (via connector 92).

With regards to claim 9, the patent to Sodemann et al. discloses that the additional voltage source (10) is electrically connected to further electrical or electronic circuits or further auxiliary devices of the handheld work machine (90), and supplies a voltage to these (via connector 92).

Response to Arguments

Applicant's arguments filed on 10/19/2009 have been fully considered but they are not persuasive.

Applicant's Argument

In the Office Action mailed July 20, 2009, claims 1 and 7-9 were rejected under 35 USC §103(a) as being unpatentable over Sodemann et al. (7,148,580). In response applicant has amended independent claim 1 to include as a limitation that the voltage source is integrated and that it "can be plugged to or in or into a housing (10) of the hand held work machine (100)." The addition of this limitation by amendment distinguishes the pending claims from the cited prior art.

[1] Specifically, the Sodemann reference is directed to an energy source that can be used to start up a generator or other type of outdoor power equipment. Sodemann is not directed to a hand-held work machine. **The energy source in Sodemann is itself a hand-held machine that must be carried around and/or transported separately from the generator or other type of outdoor power equipment which it powers according to Sodemann.** In contrast, the voltage source of the claimed invention is integrated with the hand-held machine such that the hand-held machine remains usable and transportable while the voltage source is plugged to or in or into the housing thereof. In addition, Sodemann does not feature an integrated power source. Such an integrated power source in the field of hand-held tools is not only new but also a significant aid for every person skilled in the art that works with a hand-held tool operated by a combustion engine. The integrated voltage source provides the power necessary to start the combustion engine which can at times be complicated without such an integrated voltage source. As used herein, integrated refers to a voltage source that is fitted with the hand-held work machine as an integral part thereof but is also exchangeable or replaceable with another integrated voltage source.

[2] Further, the Office Action contends that Sodemann discloses that the supply voltage required during operation of the combustion engine is split into an ignition voltage and a control voltage. Nowhere does Sodemann disclose splitting the supply voltage into distinct ignition and control voltages. Further, the Office Action contends that Sodemann discloses that the additional voltage source only supplies the required

Art Unit: 3747

control voltage prior to the start of the engine. Again, nowhere in Sodemann is it suggested that the additional voltage source supplies only the required control voltage prior to the start of the engine. Applicant respectfully submits that the claims, as amended, are in condition for allowance, notice of which is respectfully requested.

Examiner's Response to Arguments

With regards to Applicant's first argument, the reference to Sodemann ostensibly discloses an integrated voltage source in Figure 12 as provided below.

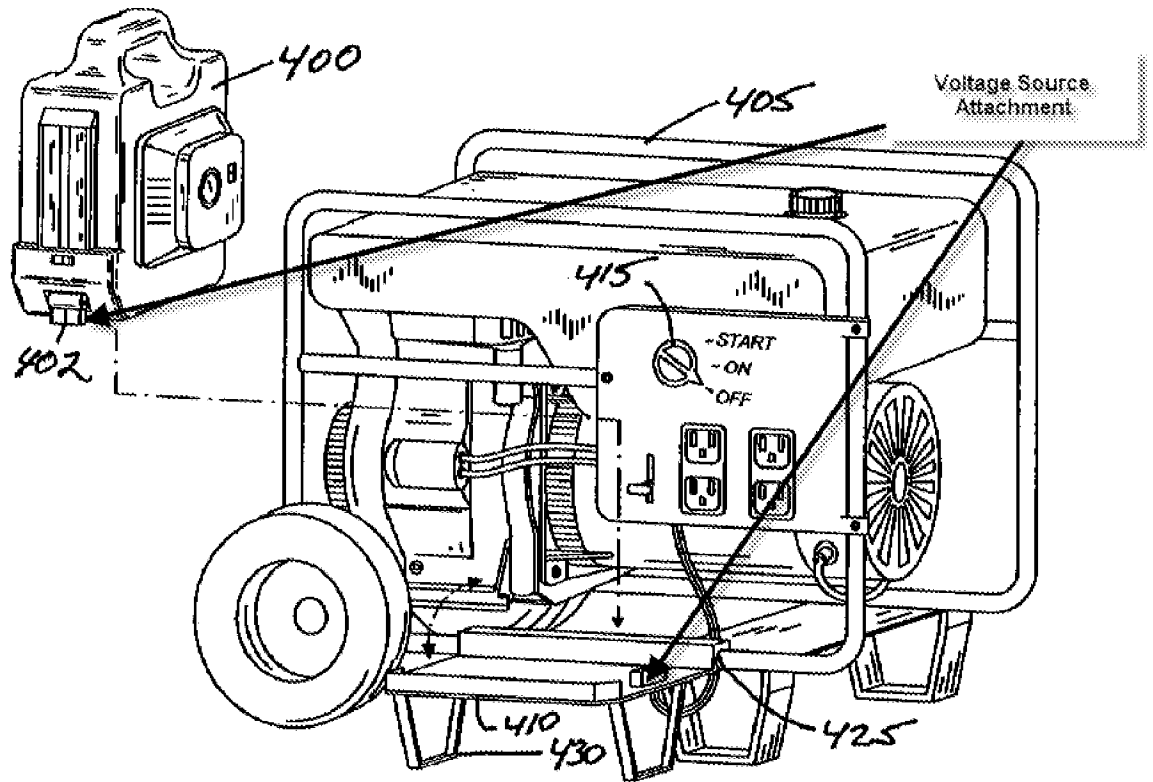


FIG. 12

On Col. 6, Lines 43-60, the reference at Sodemann discloses,

“FIG. 12 illustrates another embodiment where the pack 400 is the primary source of starting power and the pack 400 includes a pivotable Anderson connector 402. The generator 405 includes a tray 410 that receives the pack 400. The start switch for starting the generator 405

Art Unit: 3747

can be located on the pack and/or the generator. For the embodiment shown, the START switch 415 is located on the generator 405 and the starting of the generator 405 is similar to the generator 320 shown in FIG. 8B. Once the generator 405 starts, the pack 400 can be removed and the operator rotates the tray 410 toward the generator 405 on hinge 425. In the construction shown in FIG. 12, the tray includes support structures 430 on the side opposite the side receiving the pack 400. **The support structures 430 can contact the ground when the tray is rotated away from the generator 405.** It is envisioned that other receptacles can be used for receiving the pack 405 in place of tray 410 **and other types of battery packs can be used in place of pack 400.**"

As such, Applicant's arguments are moot and untenable.

With regards to Applicant's second argument, Applicant is reminded to see MPEP 2114, regarding functional language.

APPARATUS CLAIMS MUST BE STRUCTUR-ALLY DISTINGUISHABLE
FROM THE PRIOR ART

>While features of an apparatus may be recited either structurally or functionally, claims< directed to **>an< apparatus must be distinguished from the prior art in terms of structure rather than function.** >In re Schreiber, 128

Art Unit: 3747

F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Clearly, in this case, Applicant's claims are drawn to an apparatus.

Lastly, the level of specificity in Applicant's remarks and specification are not found in the claim language. Applicant is reminded to see MPEP 2111. The court explained that "reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly **adding disclosed limitations which have no express basis in the claim.**" The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)

As such, this action is made final.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH COLEMAN whose telephone number is (571)270-3516. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Cronin can be reached on 571-272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3747

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KAC

/K. C./

Examiner, Art Unit 3747

/Stephen K. Cronin/

Supervisory Patent Examiner, Art Unit 3747